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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,742

01/17/2006

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G12-197996C/KK

1838

21254 7590 11/09/2010  
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EXAMINER

MARKS, JACOB B

ART UNIT

PAPER NUMBER

1729

MAIL DATE

DELIVERY MODE

11/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,742	<b>Applicant(s)</b> ENDO ET AL.	
	<b>Examiner</b> JACOB MARKS	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,13-15,17-21 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) 6-8,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,13-15,17,18,21 and 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-14-2010</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1, 4-8, 13-15, 17-21, and 24-29 are pending. Claims 2, 3, 9-12, 16, 22, and 23 are cancelled. Claims 6-8, 19, and 20 are withdrawn.

The text of those sections of 35 U.S. Code not included in this action can be found in the previous Office Action issued 06-10-2010.

#### ***Claim Rejections - 35 USC § 112***

The claim rejections under 35 U.S.C. 112 as being indefinite on claims 21 and 28 are withdrawn in light of applicants persuasive argument.

#### ***Claim Rejections - 35 USC § 103***

The claim rejections under 35 U.S.C. 103(a) as being unpatentable over Shiozaki et al. (WO 03/044881) in view of Cho et al. (US Pub. 2003/0211391) on claims 1, 4, 5, 13-15, 17, 18, 21, and 24-29 are withdrawn in light of applicant's persuasive arguments.

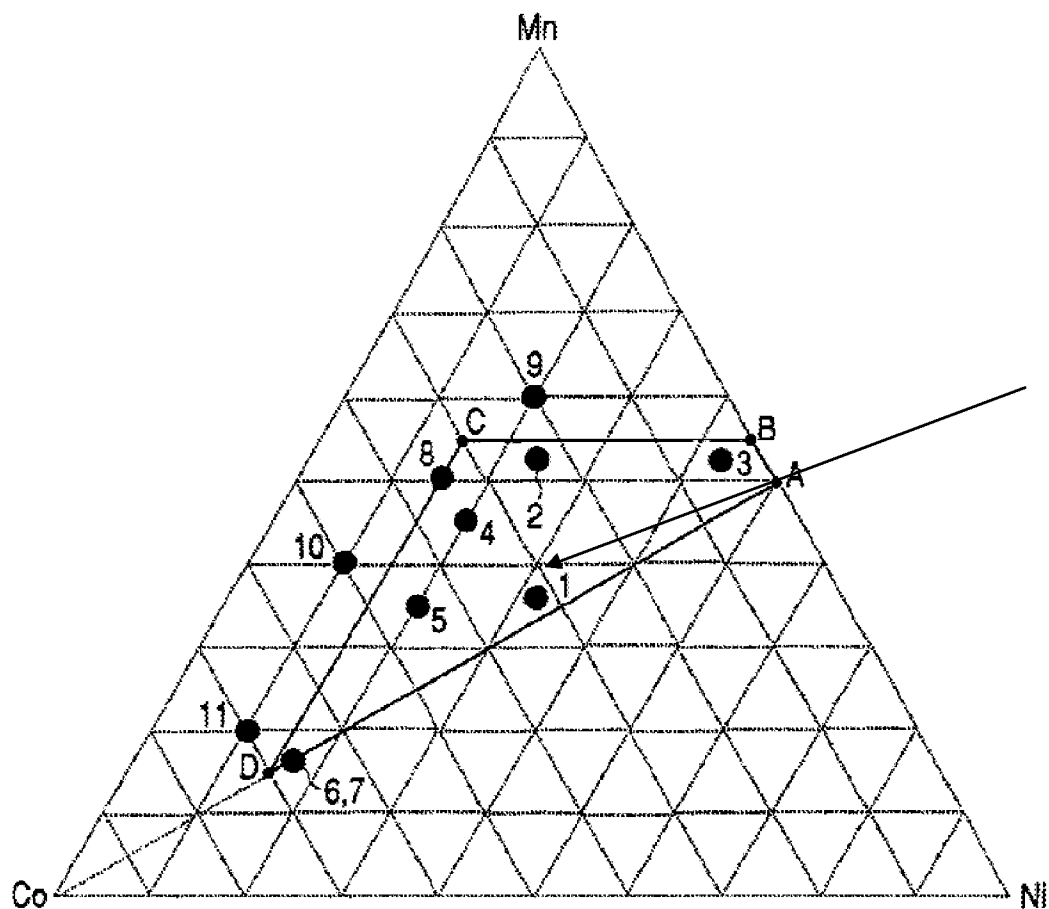
The claim rejections under 35 U.S.C. 103(a) as being unpatentable over Shiozaki et al., Howard, and Tsushima et al. (US 6,294,292) on claim 16 is because the claim has been cancelled.

Claims 1, 4, 5, 13-15, 17, 18, 21, and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiozaki et al. (WO 03/044881, for English translation see US Pat. No. 7,393,476) in view of Chen et al. (CN 1416189).

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Regarding claims 1, 4, 5, 17, 18, 24, 25, and 29, Shiozaki et al. discloses a positive active material containing lithium (base particle) (abstract). Inherent in a positive active material containing lithium is the ability to dope and release lithium ions. Shiozaki et al. further disclose a positive active material containing lithium comprising  $\text{Li}_x\text{Mn}_a\text{Ni}_b\text{Co}_c\text{O}_2$  (base particle) (see abstract). Shiozaki further discloses that the positive active material may comprise  $\text{LiCoO}_2$  which corresponds to point A on fig. 1. Shiozaki et al. further discloses a positive active material corresponding to the claimed composition wherein  $a=0.3$ ,  $b=0.3$ ,  $c=0.4$  and  $0.95 < x < 1.3$  (see abstract; fig. 1). Shiozaki et al. also disclose that the structure of the positive active material is an  $\alpha\text{NaFeO}_2$  structure (abstract).

**FIG. 1**



Shiozaki et al. does not disclose an element that is not a part of the base particles that is able to come into contact with the electrolyte is formed on base particles. However, Chen et al. disclose a positive electrode for a lithium secondary battery that is covered in a composite material (formed on the surface and not incorporated in the base particles) that may comprise an oxide of Y, Yb, Gd, Ce, or La (claims 1 and 4, abstract). Such a coating would come into contact with the electrolyte of the battery. Chen et al. disclose that coated electrode battery has a high reversible

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capacitance (abstract). Applicant should note that the machine translation refers to the electrode as “anodal,” however, it is apparent from the English abstract that the coating is to be applied to the cathode. Therefore, it would have been obvious to one of ordinary skill in the art to combine the active material of Shiozaki et al. with a composite covered electrode because Chen et al. disclose that such a composite covering on an electrode can form a battery having a high reversible capacitance.

Regarding claim 13, it is implicit in Shiozaki et al. that the positive active material is for use in a positive electrode (abstract). Shiozaki et al. further discloses that the positive active material is for use in a lithium secondary battery (abstract).

Regarding claim 14, Shiozaki et al. disclose a lithium secondary battery, with a positive electrode, a negative electrode capable of doping and undoping lithium ions and a nonaqueous electrolyte (col. 12 lines 42-50).

Regarding claim 15, Shiozaki et al. disclose that the batteries using the positive active material have obtained voltages as high as 5 V and that the batteries have been tested at voltages of 4.6 V (col. 29 line 63-col. 30 line 4).

Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiozaki and Chen et al. as applied above, further in view of Cho (US Pub. 2003/0211391).

Regarding claims 21 and 28, the combination of Shiozaki and Chen do not specifically disclose that weight percentage of the elemental oxide is between 0.5% and 4%. However, Cho discloses that the amount of a rare earth element (e.g. Gd, Yb) added to treat the surface of a positive electrode can effect the thermal stability of the

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electrode surface (par. 64-66 (examples 1 and 2), par. 77-79 (table 2)). Therefore, the concentration of the surface elemental oxide added to the active material is a known result effective variable. The optimization of a known result effective variable is within the ambit of one of ordinary skill in the art. See, *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); MPEP 2144.05(II)(B). Therefore, it would have been obvious to one of ordinary skill in the art to optimize the concentration of the element in the surface coating relative to the active material in the combination of Shiozaki and Chen because Cho teaches that the concentration of the surface coating element can affect the thermal stability of the active material.

Regarding claims 26 and 27, Shiozaki et al. discloses that it is for use in a lithium non-aqueous electrolyte battery (col. 1 lines 13-21). Lithium batteries inherently have negative electrodes containing negative active material that is able to dope and undope lithium ions. Shiozaki et al. disclose that the batteries using the positive active material have obtained voltages as high as 5 V and that the batteries have been tested at voltages of 4.6 V (col. 29 line 63-col. 30 line 4).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 4, 5, 13-15, 17, 18, 21, and 24-29 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB MARKS whose telephone number is (571)270-7873. The examiner can normally be reached on Monday through Friday 7:30-5:00 alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ula Ruddock can be reached on 571-272-1481. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacob Marks/

/Ula C Ruddock/  
Supervisory Patent Examiner, Art Unit 1795